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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/660,888      09/13/00      YAMAGUCHI      T      A0-104 US

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2222 WELLINGTON COURT  
LISLE IL 60532

MM92/0131

EXAMINER

FIGUEROA, F

ART UNIT

PAPER NUMBER

2833

DATE MAILED:

01/31/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/660,888

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Felix O. Figueroa

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

The disclosure is objected to because of the following informalities:

OK Any abbreviation should be written out initially. Therefore, "USB" in page 4 line 23, and "DIP", in page 10 line 4 should be spelled out.

Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the engagement projections on the housing, and the slots between the retention member engaging the projections, as required by claim 12.

### *Drawings*

OK Figures 15 and 16 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

OK The drawings are objected to under 37 CFR 1.84(p)(1) because reference characters must not be used in association with brackets or inverted commas, or enclosed within outlines, e.g., encircled.

OK The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because the same reference character must never be used to designate different parts. See Fig. 10 reference characters 1-4.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the projections in the housing as well as the slot, which separate retention members, and engaging the

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projections must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### ***Claim Objections***

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "generally" in claim 1 is a relative term which renders the claim indefinite. The term "generally" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 1 recites the limitation "the form" in line 13. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "said connector housing top wall portions" in lines 5 and 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "said outer shell member" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 21 recites the limitation "said space" in lines 13 and 14. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Wu et al. (US 6,086,421) in view of Futatsugi et al. (US 6,077,120).

Wu discloses a connector housing (1) having a plurality of conductive terminals (2) having contact and tail portions, a body portion, a top wall portion (11) and a bottom wall portion (17) defining a space (10) and having no sidewalls interconnecting the top and bottom walls, the body portion, the top and bottom walls defining a U-shaped cross section, a metal shell member (3) having a front face panel (32) having an opening and a frame portion around the opening defining the front end of the connector, a top panel portion (34), a bottom panel portion (31) and two side panels (33) forming a receptacle cooperatively with the top and bottom wall portions on the housing. Wu does not disclose a retainer in the form of a metal shield. However, Futatsugi teaches a retainer

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in the form of a metal shield having a retention member (77) bent upon itself and extending downwardly into a top opening and having a free end to shield the housing and retain an opposite connector within the connector housing. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a retainer in the form of a metal shield having a retention member as taught by Futatsugi to shield the housing and retain an opposite connector within the connector housing. Wu also teaches the use of retention members (322) having free ends and extending sideways. It would have been obvious modification to one having ordinary skill in the art at the time the invention was made to use the retention member on either the shell or the shield, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claims 4, 5 and 7, Wu shows bottom panel portion, top panel portion, and the side panels integrally formed with the front panel and being folded along side edges of the connector housing top wall portion.

Regarding claim 8, Wu discloses cooperating engagement means on the top panel and the side panel portions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the engagement means on the bottom panel, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claim 9, Wu discloses the claimed invention except for the location of the slot and the engagement tabs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to reverse the location of the

engagement means, since it have been held that a mere reversal of the essential parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

Regarding claim 10, Futatsugi discloses the shield and shell member made from single metal plates, in column 2 line 25.

Regarding claim 11, Wu includes a slot on the side portion separating the retention members.

Regarding claim 14, Futatsugi shows a portion of the shell (40) overlying a portion of the shield (70).

Claims 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Futatsugi et al. in view of Matsunuma et al. (US 5,993,258).

Futatsugi discloses a connector (10) comprising an insulative housing (20) having an interior receptacle supporting a plurality of conductive terminals (30), a retainer shield bent to overlies at least three sides of the housing and a retention member (77). However Futatsugi does not disclose a plurality of retention members.

Matsunuma teaches a plurality of retention members oriented in distinct vertical and horizontal planes to engage and retain a mating plug in orthogonal directions.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include more retention members as taught by Matsunuma to engage and retain a mating plug in orthogonal directions.

Regarding claim 20, Futatsugi shows an outer shell (40) partially retaining and overlying a portion of the shield (70).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Futatsugi et al. and Matsunuma et al. as applied to claim 17 above, and further in view of Wu et al.

Futatsugi discloses an outer shell (40) having a front panel portion with an opening formed therein. However, Futatsugi discloses a shell overlying three surfaces of the connector housing. Wu teaches an outer shell (3) overlying at least four different surfaces of the connector housing to provide an extensive protection. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use an outer shell (3) overlying more area as taught by Wu to provide an extensive protection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 09/660,907 in view of Futatsugi. It would have been an



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obvious modification to add the metal shield to provide more protection as taught by Futatsugi.

This is a provisional obviousness-type double patenting rejection.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (703) 308-0097. The examiner can normally be reached on Mon.-Fri., 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

ffr  
January 25, 2001

  
**RENEE LUEBKE**  
**PRIMARY EXAMINER**